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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/458,369	12/09/1999	Tad Dennis Brockway	MSI-436US	8771

7590 06/05/2003

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EXAMINER

THOMPSON, MARC D

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/458,369

Applicant(s)
Brockway et al.

Examiner
Marc Thompson

Art Unit
2142



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 30, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Dec 9, 1999 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on 3/5/2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/458,369 is acceptable and a CPA has been established. An action on the CPA follows.
2. Claims 1-46 remain pending.

Priority

3. No claim for priority has been made in this application.
4. The effective filing date for the subject matter defined in the pending claims in this application is 12/9/1999.

Drawings

5. The Examiner contends that the drawings submitted on 12/9/1999 are acceptable for examination proceedings.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3, 18, 26, 27, 40, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out, distinctly claim, and specifically set forth the subject matter which Applicant regards as the invention.

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8. Claim 18 is in improper dependent form for failure to specify a parent claim (i.e., a claim which is further limited), thereby lacking prima facie claim dependency. For the purpose of examination, claim 18 is assumed to further limit claim 14.

9. Claims 3, 26-27, 40, and 43 recite the limitation "significant [client user] interaction", rendering these claims indefinite for the inability to determine what constitutes "significant client user interaction". First, "significant" is a relative term which does not precisely specify any given amount to provide metes and bounds to the operative action(s), i.e., user interaction. Second, the term "significant" is not defined by the claim, the specification does not provide a standard for ascertaining any requisite degree, and one of ordinary skill in the art would not have been reasonably apprised of the scope of the invention. For the purpose of examination the term significant will be omitted from the claim language.

Appropriate correction is required.

Claim Objections

10. Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

11. Claims 1-46 are objected to under 37 CFR 1.75(a), for using specific words as known in the art contradictory to known and accepted meanings, resulting in confusion of the claimed invention. As known in the art, "clients" were computing terminal(s) and associated process(es)

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which requested some network service. "Servers" were the computing terminals and associated process(es) which provided a service in response to a client request, e.g., printers, file storage, etc. Claim 1 recites "a system having a server and a client" which describes installation of a peripheral device (server) at a [network] client [terminal], installing "server support" in a non-specified location. Further, functionality describing server transmission of information to and from the client happens without any type of dictated request, providing confusion concerning which terminal(s) are client, servers, or both. Applicant is advised to uniquely identify every and each machine involved with the claimed process, and how all the elements interact with each other to result in the benefit(s) outlined in the specification.

12. Further, the breadth of the presented claims is unwarranted. The claims lack details required to determine exactly what is occurring, even in light of the specification. Applicant is advised to revise the claims such that the claims are commensurate with the "client-side caching" description provided within the description. The present claims do not presently describe in any amount of detail, the actual use of client cached peripheral information for maintaining updated service records as described in the specification.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

14. Claims 1-3, 5-10, 12-23, 25-31, 33-40, and 42-45 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Golson et al. (U.S. Patent Number 5,761,505), hereinafter referred to as Golson.

15. Regarding claims 1, 13, 14, 17, 19, 25 and 33, and 42, Golson taught installing server support (Column 6, Lines 56-65) for a peripheral device attached at the client (Figure 1, printer 24 attached to client computer 14c, Column 6, Lines 26-31), transmitting (Column 6, Lines 56-65) server support configuration information (Column 6, Lines 1-24) related to the peripheral device to the client (Column 7, Lines 36-60), and storing the transmitted server support configuration information at the client (Column 5, Lines 57-67).

16. Regarding claims 2, 18, 21, 37, and 44, transmitting peripheral device settings to the server upon reconnection (Column 6, Lines 35-65).

17. Regarding claims 3, 5, 7, 26-28, 39-40, and 43, Golson disclosed disconnection of client from server (Column 7, Lines 36-60), establishing a new connection (Column 6, Lines 32-65), transmitting configuration information to the server (Column 6, Lines 56-65), and utilizing the configuration information to provide a peripheral server (Column 5, Lines 57-67).

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18. Regarding claims 6, 20, 22, 29, and 38, Golson disclosed effecting device setting changes (Column 8, Lines 37-39).

19. Regarding claims 8, 23, 30, 34, 36, and 45, Golson taught the peripheral device comprising a printer (inter alia, Column 4, Lines 65-66).

20. Regarding claims 9, 15, 31, and 35, Golson disclosed effecting the uninstallation of peripheral server support (Column 8, Lines 37-39).

21. Regarding claims 10, 16, and 31, Golson disclosed the overwriting of data related to server settings (Column 8, Lines 15-21).

22. Regarding claim 12, Golson taught the configuration information includes one or more of the following: peripheral device name, port name, queue name, queue redirection information, redirected port information, and driver name (inter alia, Column 6, Line 3, printer name).

Since Golson disclosed all the claimed limitation of the invention as broadly set forth, claims 1-3, 5-10, 12-23, 25-31, 33-40, and 42-45 are rejected.

23. Claims 1, 8, 12-14, 17, 19, 23, 25, 30, 33, 34, 36, 42, and 45 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Lomas et al. (U.S. Patent No. 6,424,424), hereinafter referred to as Lomas.

24. Regarding claims 1, 13, 14, 17, 19, 25 and 33, and 42, Lomas taught installing server support (Column 2, Line 42) for a peripheral device attached at the client (Figure 1, printer 12 attached to client processor 14, Column 1, Lines 38-47), transmitting (Column 3, Lines 39-43)

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server support configuration information (Column 3, Lines 4-10) related to the peripheral device to the client (Column 3, Lines 39-43), and storing the transmitted server support configuration information at the client (Column 3, Lines 21-23).

25. Regarding claims 8, 23, 30, 34, 36, and 45, Lomas further taught the peripheral device comprising a printer (Column 2, Lines 33-35).

26. Regarding claim 12, Lomas further taught the configuration information includes one or more of the following: peripheral device name, port name, queue name, queue redirection information, redirected port information, and driver name (Lomas Column 4, Lines 2-3 printer's name).

Since all the claimed limitations as broadly set forth in claims 1, 8, 12-14, 17, 19, 23, 25, 30, 33, 34, 36, 42, and 45 were expressly taught by Lomas, these claims are rejected.

Claim Rejections - 35 USC § 103

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

29. Claims 2-7, 18, 20-22, 26-29, 37-38, 40-41, and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lomas et al. (U.S. Patent 6,424,424) as applied above, further in view of Yellepeddy et al. (U.S. Patent No. 6,288,790), hereinafter referred to as Yellepeddy.

30. Regarding claims 2, 18, 21, 37, and 44, Lomas taught the invention substantially as claimed as noted above. Lomas taught transmitting the server support configuration information from the client to the server (Lomas column 3, lines 59-61). Lomas did not expressly teach reconnection of the client and the server. However, in art related to print support for mobile data processing systems, Yellepeddy taught detecting reconnection of the data processing system to the selected printer or print server (Yellepeddy Column 1, Lines 60-62). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the installation of shared printers on a network provided by Lomas with the automatic network printer configuration teachings of Yellepeddy since reliability was achieved by providing no noticeable loss of services during disconnections of nodes on the network, and current, accurate network device information being available for network management.

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31. Regarding claims 3, 5, 7, 26-28, 39-40, and 43, Lomas and Yellepeddy taught the invention substantially as claimed as noted above. Lomas further taught establishing a new connection between the client and the server (Column 3, Line 19), transmitting the configuration information stored at the client to the server (Column 3, Lines 59-61), and utilizing the transmitted configuration information at the server to automatically restore the server support for the peripheral device without requiring interaction from a user (Column 3, Lines 27-35 without requiring further user interaction & Figure 1, controlling software 26-36). Yellepeddy further taught disconnecting the client from the server. (Yellepeddy Column 3, Lines 58-60 & Column 4, Lines 11-15 mobile print mode wherein the client data processing may be physically disconnected from the network connected containing the remote printer queue). Lomas also disclosed transmitting the peripheral device settings from the client to the server upon the establishment of a connection between the client and the server (Column 3, Lines 59-61), transmitting the peripheral device settings (Column 4, Lines 2-6 printer object created from SLP packet) from the server to the client together with the configuration information (Column 4, Lines 5-12 & 17-18), and storing the peripheral device settings at the client (Column 3, Lines 21-23).

32. Regarding claims 4 and 41, Yellepeddy further taught a different server. (Yellepeddy taught the user may shift a transient printer queue to replay print jobs to a different remote printer queue on a different server Column 6, Lines 63-67).

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33. Regarding claims 6, 20, 22, and 29, Lomas taught retransmitting the peripheral device settings from the client to the server whenever a peripheral device setting is changed (Column 4, Lines 52-55).

34. Regarding claim 7, Lomas further taught the peripheral device settings are transmitted contemporaneously (concurrently) with the configuration information (Column 3, Lines 7-8 & Column 4, Lines 5-12 & 17-18 necessary parameters and SLP packet are downloaded by client).

Since the claimed limitations of claims 2-7, 18, 20-22, 26-29, 37-38, 40-41, and 43-44 were disclosed by the combination of Lomas and Yellepeddy, these claims are rejected.

35. Claims 9, 10, 15, 16, 31, 35, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lomas (U.S. Patent No. 6,424,424) as applied above, in view of Huang et al. (U.S. Patent No. 6,131,134), hereinafter referred to as Huang, further in view of White et al. (U.S. Patent No. 6,301,012), hereinafter referred to as White.

36. Regarding claims 9, 15, 31, and 35, Lomas taught the invention substantially as claimed as noted above. Lomas did not teach uninstalling server support for the peripheral device attached at the client. However in art related to hot plug n play, Huang taught disabling related drivers corresponding to uninstalling server support (Column 5, Line 47). Huang further taught transmitting new server support configuration information to the client (Column 5, Line 41-42), the new server support configuration information indicating that server support for the peripheral device has been uninstalled (Column 8, Lines 35-36). Neither Lomas or Huang specifically

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taught deleting the stored configuration information related to the uninstalled peripheral device from the client. However in art related to automatic configuration of network peripherals, White taught when configuration parameters change, modifying configuration parameters accordingly (Column 4, Lines 42-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of network printer installation provided by Lomas with the teachings of bus extension provided by Huang and the configuration of a network printer provided by White, to result in the replacement of client stored peripheral information since detecting uninstalled server support and updating configurations dynamically allows for consistent, accurate network information.

37. Regarding claims 10, 16, and 31, the combined teachings of Lomas, Huang, and White taught that deleting was accomplished by overwriting the stored configuration information with the new server configuration information (White, Column 4, Lines 42-46).

38. Claims 11, 24, 32, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lomas et al. (U.S. Patent Number 6,424,424) as applied above, in view of White et al. (U.S. Patent No. 6,301,012).

39. Regarding claims 11, 24, and 46, the combination of Lomas and White taught renaming a queue associated with the peripheral device that was created when the peripheral device was installed on the server (White Column 4, Lines 49-58 proper print queue is created), transmitting subsequent configuration information from the server to the client, the configuration information

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denoting the renamed queue (Lomas, Column 4, Lines 8-12), and storing the subsequent configuration information denoting the renamed queue at the client (Lomas, Column 3, Lines 21-23).

40. Regarding claim 32, Lomas and White taught the server further configured to create a virtual port that is utilized by the client (White, Column 4, Lines 17-20), and include information regarding the virtual port in the configuration information sent to the client (Lomas, Column 4, Lines 2-3 SLP packet info).

41. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of network printer installation provided by Lomas with the teachings of automatic configuration of a network printer provided by White, to result in the replacement of client stored peripheral information since detecting uninstalled server support and updating configurations dynamically allows for consistent, accurate network information.

42. Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gase et al. (U.S. Patent Number 5,580,177), hereinafter referred to as Gase, in view of Urevig et al. (U.S. Patent Number 6,154,787), hereinafter referred to as Urevig.

43. Gase disclosed a centralized server acting to maintain records associated with various network printers. See Column 3, Lines 4-16. This central server further provided printer drivers for installation at client terminals for usage of network printers. See Column 3, Lines 51-67. The printers were server-based services and configuration of these peripheral devices were

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transmitted to client terminals. See, inter alia, Column 4, Lines 35-37. Recitation of “configuration information related to the [peripheral] device”, as claimed, being “transmitted to the client”, is broad enough to include a simple indication of availability. Further, the driver(s) themselves, constitute configuration information, since drivers were routinely updated, revised, and required for printer usage. See Gase, Column 4, Lines 10-26.

44. While Gase disclosed the invention substantially as claimed, Gase did not specifically disclose the connection of a printer to one of the clients of the networking system. An artisan of ordinary skill at the time the invention was made, would have been aware that an arbitrary client computer has connected peripheral devices, and these devices included printers which were well known to have been shared network devices. See Gase, Column 1, Lines 18-53. Thus, an artisan would have been motivated to search the related arts of network shared peripheral devices to isolate teachings directed toward configuration of local peripherals as network shared devices.

45. In this art, Urevig disclosed the reassignment of network resources relating to shareable peripheral devices which included printers and tape drives. See Column 2, Lines 25-35, and Column 5, Lines 14-24. Also note, Column 4, Lines 61-64, where functionality of the disclosed method(s) was disclosed as operative on standard personal computers. The teachings of Urevig resulted in a shared resources system which dynamically managed and allocated shared peripheral device usage (i.e., servers) to requesting process(es) (i.e., clients), with minimal user input. See Column 2, Lines 48-67. The resultant system of the combination of the Gase and Urevig teachings would have been understood by an ordinary artisan at the time the invention

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was made as one which provided centralized printer driver and status management while dynamically managing sharable network resources for the host(s) which both provide and request services of the network. See Gase, Column 2, Lines 36-54, and Urevig, Column 2, Lines 48-67.

46. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gase and Urevig to result in a system providing printing services, printer status monitoring, centralized printer driver (configuration) maintenance, and timely, automated reassignment of network shared resources. The claimed invention was fully taught by this proposed combination, as follows:

(Claims 1, 13, 14, 17, 19, 25, 33, 42)

a. Installing server support for a peripheral device attached at the client (Gase, Column 1, Lines 43-46, Urevig, Column 2, Lines 58-67), transmitting configuration information for the peripheral to the client (Gase, Column 4, Lines 27-35, Urevig, Column 4, Lines 35-37, Column 7, Lines 26-51), storing the configuration information at the client (Gase, Column 4, Lines 27-35, Urevig, Column 8, Line 19 through Column 9, Line 48),

(Claims 2, 18, 21, 37, 44)

b. Transmitting configuration information from the client to the server upon reconnection of the client and server (Gase, Column 4, Lines 39-45, Urevig, Column 10, Lines 41-55),

(Claims 3, 5, 7, 26-28, 39, 40, 43)

c. Disconnecting and reconnecting the server and client, (Gase, Column 4, Lines 36-59, Urevig, Column 8, Lines 5-18, Column 10, Lines 41-55), transmitting the configuration

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information stored at the client to the server (Gase, Column 1, Lines 43-46, Column 4, Lines 41-45, Urevig, Column 5, Lines 36-46), utilizing the configuration information to automatically restore the server support for the peripheral device (Gase, Column 4, Lines 39-45, Urevig, Column 10, Lines 41-55).

(Claims 4, 41)

d. Transmitting the configuration information at the client to a different server, would have been obvious to one of ordinary skill in the art at the time the invention was made in order to provide redundancy; multiple servers were notoriously well known to work in parallel to avoid loss of complete network functionality when a single server failed.

(Claims 6, 20, 22, 29, 38)

e. Retransmitting device settings from the client to the server whenever a peripheral device setting is changed, (Gase, Column 4, Lines 39-45, Urevig, Column 2, Lines 58-61)

(Claims 8, 23, 30, 34, 36, 45)

f. Peripheral device is a printer, (Gase, Column 1, Lines 35-54, Urevig, Column 5, Lines 19-22)

(Claims 9, 15, 31, 35)

g. Uninstalling server support for the peripheral device (Urevig, Column 8, Lines 56-61, Column 10, Lines 41-55).

(Claims 10, 16, 31)

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h. Overwriting the stored configuration information with new server configuration information (Gase, Column 4, Lines 10-59, Urevig, Column 9, Lines 20-41)
(Claims 11, 24, and 46)

i. [maintaining] a queue for the peripheral device, (Gase, Column 4, Lines 10-26, Column 5, Lines 34-37)
(Claim 32)

j. Creation and maintenance of virtual ports for the peripheral service (Urevig, Column 10, Lines 62-65). TCP/IP inherently provided well-known port assignment for server responses.

47. Thus, since all the claimed limitations were disclosed by the combination of Gase and Urevig, claims 1-46 are rejected.

Conclusion

48. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Marbry et al. (U.S. Patent Number 5,692,111) disclosed the automatic installation of shared network printers.

b. Tezuka et al. (U.S. Patent Number 6,018,769) disclosed a specialized shared network printer installation system.

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49. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc Thompson whose telephone number is (703) 308-6750. The Examiner can normally be reached on Monday-Friday from 9am to 4pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mark Powell, can be reached at (703) 305-9703.

The fax phone numbers for the organization where this application is assigned are as follows:

(703) 746-7238	(After Final Communications only)
(703) 746-7239	(Official Communications)
(703) 746-7240	(for Official Status Inquiries, Draft Communications only)

Inquiries of a general nature relating to the general status of this application or proceeding should be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900, or Customer Service for Technology Center 2100 at (703) 306-5631.


Marc D. Thompson
Patent Examiner
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